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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,054	03/28/2001	Adam R. Schran	10397-1U1	3079

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EXAMINER	
LEROUX, ETIENNE PIERRE	
ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/820,054	SCHRAN ET AL.	
	Examiner	Art Unit	
	Etienne P LeRoux	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 November 2006* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 January 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claims Status

Claims 1-30 are pending. Claims 1-30 are rejected as detailed below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,286,001 issued to Walker et al (hereafter Walker) and further in view of US Pat No 6,851,060 issued to Shrader (hereafter Shrader), as best examiner is able to ascertain.

Claim 1:

Walker discloses:

(a) receiving, at a server, a request from a subscriber to send a list of sources to the client machine [Walker, Internet service provider server 140, web site authorization server 150, personal computer 100, Fig 1]

(b) downloading the list of sources from the server to the client machine [Walker, initial pre-approved list is downloaded from web site authorization server 150, col 11, lines 25-30]

Walker discloses the elements of the claimed invention as noted above but does not disclose cookie file source(s). Shrader discloses cookie file source(s) [col 2, lines 64-67]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify Walker to include cookie file source(s) as taught by Shrader for the purpose of providing authorized websites suitable for accessing by children [Walker, col 7, lines 45-60] by blocking the cookie file received from a particular source/website [Shrader discloses blocking all cookies from an undesirable web server that returns only advertisement graphics, col 2, lines 64-67, and automatically accepting cookies from desirable web sites [col 7, lines 30-35].

Furthermore, it is noted that Shrader also discloses a list of cookie file sources from desirable web sites [Cookie Table, Fig 7, step 405, col 7, lines 10-15]

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Walker and Shrader because both references deal with the same problem, i.e., blocking web sites which contain undesirable material and permitting web sites which contain desirable material.

The combination of Walker and Shrader discloses (c) using the downloaded list of cookie file sources to detect cookie files received at the client machine from cookie file sources on the downloaded list by comparing the cookie file source of any received cookie file to the cookie file sources on the downloaded list [Shrader, col 5, lines 24-30, all cookies transmitted from an undesirable site can be blocked at the client machine]

Claim 2:

The combination of Walker discloses the elements of claim 1 as noted above and furthermore discloses (d) creating a first exception list including the identity of cookie file sources that are permitted to store cookies in the client machine, (e) creating a second exception list including the identity of cookie file sources that are not permitted to store cookie files in the

client machine, and (f) modifying the downloaded list in accordance with the first and second exception lists[Walker, col 3, lines 1-15]

Note: Examiner maintains when the downloaded list is examined and the parent identifies, from the downloaded list, a list (sublist) of cookie file sources that are permitted to store cookie files in the client machine the remainder of the cookie file sources on the downloaded list is the list (sublist) of cookie file sources that are not permitted to store cookie files on the client machine.

Claim 4:

The combination of Walker and Shrader discloses the elements of claim 1 as noted above and furthermore, discloses displaying a message at the client machine indicating that a cookie file received from a cookie file source on the downloaded list has been detected [Shrader, Fig 7]

Claim 5:

The combination of Walker and Shrader discloses the elements of claim 1 as noted above and furthermore discloses removing the detected cookie files stored in the client machine [Shrader, Fig 7].

Claim 6:

The combination of Walker and Shrader discloses preventing cookie files from being stored in the client machine [col 2, lines 64-67]

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Walker and Shrader and further in view of Julien Jay.

Claim 3:

The combination of Walker and Shrader disclose the elements of claimed invention as noted above but does not disclose (d) receiving updates of the downloaded list from the server on a periodic basis. Julien discloses receiving updates of the downloaded list from the server on a periodic basis [page 2, paragraph 1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify above references to include receiving updates of the downloaded list from the server on a periodic basis as taught by Julien Jay for the purpose of maintaining the list current with changes to existing web sites and with the addition of new web sites.

Regarding claims 7-30, examiner maintains that these claims can be rejected o a similar basis as claims 1-6.

Response to Arguments

Applicant's arguments filed 11/9/2006 are moot based on above new grounds of rejection necessitated by the most recent claim amendments. Nevertheless, the Declaration by Adam R Shran of April 11, 2006 is considered below.

Applicant Argues:

Applicant states the following on page 21 that the Declaration paperwork is self-explanatory.

Examiner Responds:

Examiner is not persuaded for the following reasons.

Declaration By Adam R Schran - April 11, 2006

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the US Patent Application Publication No. 2002/0055912 (Buck) reference, i.e. October 20, 2000.

A 1.131 declaration requires facts supported by objective evidence, general allegations are not sufficient. The declaration alleges "completion of the invention." Completion of invention is not language found in the MPEP. Since the Declaration does not consider conception of the invention and due diligence, examiner will interpret "completion of the invention" as actual reduction to practice. Exhibits 1-5 are considered below according to the MPEP established criteria for actual reduction to practice.

Exhibit 1 is a screen shot of a beta version of ActivePrivacy. The MPEP discloses that a process is reduced to practice when it is successfully performed. Exhibit 1 provides no evidence that the beta version of ActivePrivacy performed successfully during testing. Furthermore, it is unclear how the "beta version" corresponds to the claimed invention, i.e., that the apparatus per the claimed invention actually existed and actually worked according to its intended purpose.

Exhibit 2 can be characterized as a press release which provides no objective evidence of actual reduction to practice.

Exhibit 3 is a request for a patentability search by Akin, Gump, Strauss, Hauer and Feld. A law firm does not reduce an invention to practice by doing a patentability search.

Exhibit 4 is an email from a frustrated user who complains that ActivePrivacy "is virtually useless to me." Exhibit 4 shows that the invention did not function according to its intended purpose. Actual reduction to practice was not realized as of the date of the email.

Exhibit 5 comprises mapping the claimed invention to features of ActivePrivacy. Mapping claim limitations is unrelated to actual reduction to practice.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Pub No US/0019941 (Chan et al) discloses a list of trusted sites and a list of untrusted sites [paragraph 83].

(2) Pub No US 2002/0078191 (Lorenz) discloses as prior art, commercially available software that can block cookies at the client-side computer system [paragraphs 3 and 4]

(3) Patent Number 6,006,334 (Nguyen et al) discloses validating a cookie and subsequently accepting or rejecting the cookie [Fig 5].

(4) Patent No. 6651217 (Kennedy et al) discloses that users can block storage of cookies received from suspicious and untrusted websites [brief summary 6]

(5) Patent No 6,237,033 (Doeberi et al) discloses interpreting and blocking cookies received at a client computer system [col 5, lines 15-35]

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

11/17/2006

EP LeRoux

Primary Examiner